

Amendment

Attorney Docket No. 550718-093

Page 5 of 9

REMARKS/ARGUMENTS

Claims 1-17 are currently pending the application. Claim 17 has been added to more clearly recite aspects of a particular embodiment of the present invention. Support for claim 17 can be found in original claim 1, FIG. 3 and at page 4, lines 18 – 23 of the specification.

In the Office action, the Office has rejected Claims 1-16 as being unpatentable over U.S. Patent No. 5,301,445 to Hoffmeister in view of U.S. Patent No. 6,045,161 to Ashcraft et al.. This rejection is respectfully traversed for the following reasons.

The Office action recites Hoffmeister as teaching a binder insert comprising a transparent plastic bag-shaped body with an open upper side, a photograph store portion and a memo store portion, a store board and a binding section having a plurality of binding holes. As indicated in the Office action, Hoffmeister fails to disclose a store board comprising a thick paper folded in two and having slits at predetermined locations and slits and a color paper disposed between the thick paper surfaces. The Office relies on Ashcraft for teaching these missing elements and indicates that it would have been obvious to combine the store board as taught by Ashcraft with the binder insert disclosed by Hoffmeister. The proposed motivation for combining the references is for “mounting the photographs in a stable position on the store board.” September 10, 2003 Office action, p. 4.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the pending application because the prior art references cited by the examiner, considered either individually or in combination, fail to disclose each and every element of the claimed structure.

Initially, applicants note that neither reference discloses a memo store portion and a memo paper in the memo store portion. The memo store portion as set forth in claims 1 and 17 is formed by dividing the transparent plastic body into two portions: one for storing photographs and one for storing memos. Hoffmeister, by contrast, discloses a memo or margin area adjacent the photograph storage pockets. However, as clearly shown in Figs. 5 and 6, the memo or

Amendment

Attorney Docket No. 550718-093

Page 6 of 9

margin area is an extension of the backing sheet 18 beyond the width of the transparent sheet 24. The memo area in Hoffmeister is not a memo store portion as claimed in the present application. The Office action cites col. 1, lines 55-60 for disclosure of a memo paper inserted in a memo portion. However, the cited passage refers to items that can be displayed and stored in the storage page in general and does not refer to items to be inserted in a memo store portion because, as explained above, **Hoffmeister does not disclose or describe a memo store portion**. Accordingly, the reference fails to disclose or suggest a memo store portion and a memo inserted into the memo store portion as presently set forth in claim 1 or a memo store portion as set forth in claim 17. Accordingly, for at least this reason, applicants respectfully submit that the cited references fail to disclose this element of the claimed structure and therefore the obviousness rejection must fail as a matter of law.

Hoffmeister also fails to disclose a store board as set forth in the pending claims. The Office action identifies rectangular image 12 in Hoffmeister as a store board. However, rectangular image 12 in Hoffmeister is the photograph or other image to be displayed and does not refer to the store board set forth in the claims of the present invention. The store board is used to mount the photograph and is separate and distinct from the photograph itself.

The Office action further indicates that Ashcraft discloses a color paper (34) disposed between the thick paper surfaces of a store board 36. Applicants respectfully submit that Ashcraft fails to disclose either of these elements of the present invention. Element 36 of Ashcraft is a support sheet which includes tabs 44 for supporting display sheet 38. However, external frame 42 although integrally formed with the support sheet 36 is a frame and not a store board. There is no way of storing a photograph or other item on the frame 42. Although Applicants maintain that claim 1 is clearly distinguishable over the Ashcraft reference for this reason, claim 17 has been added to recite additional distinctions over the Ashcraft reference. Likewise, element 34 in Ashcraft is the tab assembly including the support sheet 36, display sheet 38, internal frame 40 and external frame 42. In other words, the support sheet 36 is a part of the tab assembly 34 and, therefore, it is not possible for the tab assembly 34 to be disposed

Amendment

Attorney Docket No. 550718-093

Page 7 of 9

between the thick paper surfaces of the support sheet. Therefore, for at least this reason as well, Applicants respectfully submit that the claims of the pending application are not obvious over the cited references of record.

Applicants also maintain that the cited references fail to provide the requisite motivation to combine and modify the cited prior art references.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. See, e.g., *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q. 2d (BNA) 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching may come from the prior art, the knowledge of one skilled in the art or from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the Applicants' application. *In re Paulsen*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994) ("Multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.").

The Office action indicates that it would have been obvious to combine the teachings of Hoffmeister with that of Ashcraft to teach the invention as claimed. The proposed motivation for combining the references is to provide a method of "mounting the photographs in a stable position on the store board." Applicants respectfully submit that the necessary motivation to combine these references is not present. The motivation to combine must be "clear and particular" and in the present case the purported motivation is neither.

Specifically, one of ordinary skill in the art at the time of the present invention would not have been motivated to combine Hoffmeister with Ashcraft to teach the invention as claimed because the references fail to provide any motivation to make the proposed combination. Furthermore, applicants submit that the two references are not properly combinable. One of skill

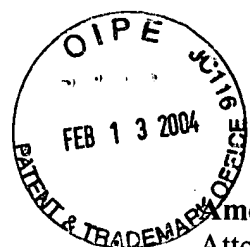
Amendment

Attorney Docket No. 550718-093

Page 8 of 9

in the art reading the Hoffmeister reference would not be motivated to combine Hoffmeister with Ashcraft's method for supporting a display sheet in a stable position since this is the exact problem that Hoffmeister addresses. Hoffmeister describes the images as being "retained in a fixed position with respect to the backing sheet, and are retained against lateral sliding movement and vertical downward movement." *See* Column 2, lines 46-50. Therefore, one of ordinary skill in the art would not need to look to other references for a method of mounting the photographs in a stable position on the store board. Furthermore, the mounting methods disclosed in Hoffmeister and Ashcraft rely on significantly different mechanisms for mounting photographs in a stable position such that combining the two would be impractical. Ashcraft discloses the use of a plurality of tabs 44 on a support sheet 36 which engage a display sheet 38 relative to the support sheet. The fixed tabs in Ashcraft provide none of the flexibility provided in Hoffmeister through the use of a plurality of brackets. There would be no advantage to using the mounting process of Ashcraft in the Hoffmeister album page. Accordingly, applicants respectfully submit that the prior art cited fails to supply the requisite motivation to combine and modify the teachings in the prior art to arrive at the present invention.

To establish a *prima facie* case of obviousness there must be some motivation or suggestion in the references that would lead one of ordinary skill in the art to combine the various components, without knowledge of the claimed invention, to obtain the present invention. *In re Kotzab*, 217 F. 3d 1365, 1371, 55 U.S.P. Q. 2d (BNA) 1313, 137 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with knowledge of the claimed invention, would have selected these components for combination in the manner claimed"). The mere identification of the various components in the prior art references is insufficient to render the present invention obvious. The motivation or suggestion "must be considered in the context of the teaching of the entire reference." *Id.* One of skill in the art reading the Hoffmeister reference would not be motivated to turn to Ashcraft for another mounting method. The references are devoid of any suggestion of picking and choosing various features of each reference to arrive at the present invention. One of skill in the art could never arrive at the present invention based on any motivation or suggestion in the references without



Amendment

Attorney Docket No. 550718-093

Page 9 of 9

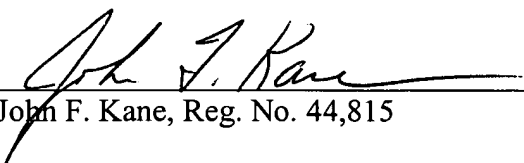
the benefit of the applicants' disclosure. Accordingly, applicants submit that the claims of the present application are not obvious over the combined teachings of the cited references.

With respect to claim 1, the Office action indicates that patentability is based on the product and not on the process of making. Applicants submit that the store board and its structure are positively recited in the pending claims and this is a moot point.

With respect to claims 6 and 12 which recite color print portions having different colors corresponding to standardized photograph sizes, the Office action indicates that "the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability." Applicants note that the color paper having color print portions is advantageous in that it provides an indication as to the proper slits to use for various size photographs. Furthermore, the presence of the color paper in the store board is advantageous in that it prevents contact between the corners or photographs inserted from each side of the store board.

In light of the foregoing response, it is respectfully submitted that claims 1-17, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested. If the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,


John F. Kane, Reg. No. 44,815

THOMPSON HINE LLP
2000 Courthouse Plaza, N.E.
P.O. Box 8801
Dayton, Ohio 45401-8801
937-443-6816

328870